



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/329,461 06/10/99 RODRIGUEZ

H AT9-99-085

TM02/0606

DUKE W YEE
CARSTENS YEE & CAHOON LLP
PO BOX 802334
DALLAS TX 75380

EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/329,461

Applicant(s)
Rodriguez et al..

Examiner
Cuong H. Nguyen

Art Unit
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 27, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 22-24 are subject to restriction and/or election requirements.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 10, 1999 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Sep 27, 1999 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the IDS received on 11/27/2000, which paper has been placed of record in the file.
2. Claims 1-28 are pending in this application.

Drawings

3. This application has been filed with informal drawings, and they are required to be corrected as indications by the draftsman.
4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 101

5. Claim 22 is rejected under 35 U.S.C. § 101 because it is directed to a non-statutory subject matter. This claim is essentially directed to a non-functional descriptive material (a computer program per se) on a computer storage medium (this is broadly claimed as an article of manufacturer). See Examination Guidelines for Computer-Related Inventions at USPTO, Section IV.B.2.
6. The remaining claims (23-24), not specifically mentioned, are rejected for incorporating a defect from their respective parent claim by dependencies.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, to make and use the same and shall set forth the best mode contemplated by the inventors of carrying out his invention.

8. Claims 25-28 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The computer program which perform purchase and validating e-receipts in claims 25-28 was not disclosed although compatible method comprising steps are acceptable. The claimed computer program for generating, recording, reading, validating an electronic receipt is essential to the practice of the invention, but only a simple flow-chart showed about related method steps; therefore, these claims about a computer program required specific instructions are not enabled by the

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tognazzini** (US Pat. 5,739,512), in view of the Official Notice.

10. Re. To claim 1/3/5: **Tognazzini** suggests a method for conducting a commercial transaction in a distributed data processing system, the method comprising the steps of:

- recording an electronic receipt (**a digital certificate**) on a removable storage medium (a smart card, see **Tognazzini**, the abstract, Fig.6A, 7, 1:47-55, 2:26-28) at a first data processing terminal, the electronic receipt (**a digital certificate**) comprising data concerning a commercial transaction (not patentable);
- receiving the removable storage medium (a smart-card) at a 2nd computer at a different time/location; (see **Tognazzini**, Figs.1-2, 6A, 7, 3:16-20; this limitation is not patentable);

The examiner submits that **Tognazzini** performs **validating an e-receipt stored on the removable storage medium/(a smart-card) at the second computer data-processing system**; (see also **Tognazzini** for an analogous step of **"sending an e-confirmation of the purchase transaction to a customer"**, 3:21-26) not patentable);and

The examiner submits that **Tognazzini** performs checking digital signatures (validating/integrity determining e-receipt) to conducting a commercial transaction (see **Tognazzini**, the abstract, Figs.4, 7).

The examiner also submits that a validated e-receipt can be in the form of a digital certificate just because a document is validated; therefore the Official Notice is taken that a reference from <http://www.findarticles.com> inherently suggests said "validation":

See Business Wire - August 26, 1998, VeriSign and Gemplus Expand Strategic Relationship; To Develop Joint Smart Card/Digital Certificate Solution For Secure Network Applications.

11. Re. To claim 2 (as claim 4): The method of claim 1 wherein the step of validating the electronic receipt **further** comprises **inspecting a digital signature**. This limitation is similar to an obvious step done by **Tognazzini** "Encryption techniques permit the secure transmission of electronic information. Well-known public/private key encryption schemes provides privacy and content security, while digital signature schemes provide for authentication of the sender. These techniques are well-understood and widely used in many applications, including electronic mail and EDI.". Therefore, this limitation is not patentable.
12. Re. To claim 3 (as claims 1, 5): Besides having several limitations as claims 1,5; this claim further discloses limitations that Tognazzini suggests:
- in response to **validating** an e-receipt,
 - a. providing an indication to proceed with a delivery of goods/services related to the purchase transaction (see **Tognazzini** 2:28-40; and

b. **updating an inventory** affected by said delivery of goods/services (see **Tognazzini** 2:61-65, 3:4-20, 3:28-38) (this updating step merely a well-known step in marketing business **resulting** from an outstanding order).

13. Re. To claim 4 (as claim 2): The method of claim 3 wherein the step of validating the e-receipt **further** comprises **inspecting a digital signature** to verify the integrity of the electronic receipt. The Official Notice is taken here that a step of inspecting a digital signature has been known. One of ordinary skill in the art would perform said inspection step as inspecting signature often gives proof for a document.

14. Re. To claim 5 (as claim 1): Besides several similar limitations in claim 1, the Official Notice is taken that the following limitations are known:

- in response to validating the electronic receipt, **providing an indication to proceed** (can be a "Y"/"O.K." signal to continue/follow to next step in business which is well-known: delivery of goods) with a delivery of goods/services related to a purchase transaction.

15. Re. To claim 6 (as claims 3, 5): The method of claim 5 further comprising:

- processing a purchase transaction (as claim 3);
- generating an e-receipt comprising data concerning the purchase transaction (as claim 3); and
- storing the electronic receipt on said removable storage medium (as claim 3);

wherein said removable storage medium **remains with a consumer** (this limitation is not patentable since "remains with a consumer" is an option, the point is "an e-receipt storing in a smart-card").

Therefore, the rationales for rejection of claims 3, 5 are applied.

16. Re. To claim 7: The method of claim 5 further comprising:

- said removable storage medium **remains with a consumer**; this limitation is already discussed in claim 6; therefore similar rationales are applied.

17. Re. To claim 8: The method of claim 5 further comprising:

- **prior to validating** the e-receipt, selecting one of e-receipts in **accordance with input** from a consumer.

The Official Notice is taken that a step of selecting a specific receipt for validating **must be made because there were different e-receipts in a storage device**. Therefore, that step is obvious in said method.

18. Re. To claim 9: The method of claim 5 wherein the e-receipt **may be** validated a number of times for a purchase transaction that requires a plurality of deliveries of goods/service (the use of "may be" means a possibility/option; it can be interpreted as "at least once". However, the Official Notice is taken here that if there are many validations the step of validating a receipt is still obvious (e.g., a purchased device having several

different components: an amplifier set, a DVD/DC player, surround sound speakers .etc. if the store is missing a speaker, then the purchase is still went thru. With a later pick-up of that missing speaker; when a customer picks-up that missing speaker, another validating of e-receipt must be made).

19. Re. To claim 10/11: The method of claim 5 wherein the e-receipt "may be" **validated for** a claim for **servicing of a product** subject to the purchase transaction.

The Official Notice is taken that for the purpose of later servicing a product, original receipt must be provided whether it is a regular receipt or an e-receipt; therefore, this limitation is obvious to one of skill in the art.

20. Re. To claim 11 (as claim 10): The method of claim 5 wherein the e-receipt **may be** validated **for** a warranty claim on goods/services subject to the purchase transaction. The examiner submits a similar rationale as for claim 10.

21. Re. To claim 12: The method of claim 5 wherein the removable storage medium is a smart card.

The examiner submits that a smart card (i.e., a credit card that contains an IC circuit that gives it a limited amount of "intelligent" and memory) or a floppy disk or a safe card are obviously classified as removable storage medium.

22. Re. To claim 13: The method of claim 5 wherein the removable storage medium is an optical card.

The examiner submits that an optical card (i.e., a compact disk) or a floppy disk are obviously classified as a removable storage medium.

23. Re. To claim 14: The method of claim 5 wherein the step of validating the electronic receipt further comprises inspecting a digital signature to verify the integrity of that e-receipt.

The examiner submits that a step of validating/checking/(verifying the integrity) obviously may means inspecting a digital signature of said document because that is one of requirements).

24. Re. To claims 15-21: These claims have similar limitations as above claimed methods although they claim data processing systems. Therefore, similar rationales and references are applied.

All the claims are directed to the use of e-receipt for online transactions wherein all claims' limitations can be found in the US patents of Tognazzini (US Pat. 5,739,512), Vaghi (US Pat. 6,047,273), Beatson et al., (US Pat. 5,892,824), and Muftic (US Pat. 5,850,442). In their disclosures, they utilized e-receipts and validating them for different purposes.

The Official Notice is also taken here that the following limitations are notorious well-known in the art (at least from cited references):

- processing means for processing a transaction;
- generating means for generating e-receipts for above transaction;
- storing means for storing e-receipts;
- reading means for reading e-receipts;
- validating means for validating e-receipts;
- indicating means for providing an indication to proceed with a delivery of related goods/services;
- inspecting means for inspecting a digital signature of e-receipts.

The examiner submits that all claimed limitations are so obvious/notoriously well-known in a computer system, because these claimed limitations are very broad that they are easily recognized by artisan in the art to be ability/features/components of a computer system and said components would perform claimed tasks/steps; cited prior art's limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for communicating between sellers and buyers through e-receipts. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited disclosures

have been described in connection with specific preferred embodiments, it should be understood that their subject matter should not be unduly limited to such specific embodiments.

Conclusion

25. All pending claims are rejected.

26. The examiner uses these US Patent case laws in this examination:

A. In re **Nomiya**, 184 USPQ 607 (CCPA 1975), the court ruled: " The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Simon**, 174 USPQ 114 (CCPA 1972); In re **McLaughlin**, 170 USPQ 209 (CCPA 1971)".

B. The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with **claims' language**. In re **Mrasz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), the court ruled: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

Note About Treatment of Combined References:

C. In re **Keller, Terry, and Davies**, 208 USPQ 871 (CCPA 1981), the court rules: "One cannot show non-obviousness by attacking references individually where rejections are based on combinations of references."

D. In re **Merck & Co., Inc.**, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by

attacking references individually where the rejection is based upon the teachings of a combination of references."

E. In re **Nievelt**, 179 USPQ 224 (CCPA 1973), the court rules: "Combining teachings of references does not involve an ability to combine their specific structures."

F. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

G. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)), the court rules: "The name of the game is the claim."

H. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims".

See In re **Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. Cited prior art disclose structures that meets the claims' limitations. See **Giles Sutherland Rich**, Extend of Protection and

Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

I. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Kuderna**, 165 USPQ 575 (CCPA 1970).

J. *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987)
Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

K. **Lamont v. Berguer**, 7 USPQ2d 1580 (BdPatApp&Int 1988)
Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts.

L. *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987)
Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703)308-1065.

Any response to this action should be mailed to:

Amendments
Commissioner of Patents and Trademarks

c/o Technology Center 2100
Washington, D.C. 20231

or faxed to: (703) 308-9051 (for formal communications intended for entry)

Or: (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
Patent Examiner

June 04, 2001